

REMARKS

The previous claims 11-19 are rewritten as new claims 29-37, with the subject matter of each new claim generally corresponding that of the canceled claims. In accordance with the Examiner's indication that claim 19 would be allowable if rewritten in independent form, new claim 38 includes the subject matter of previous claims 11 and 19 and thus is believed to be allowable. Claim 39 substantially corresponds to previous claim 21 and is believed allowable for the reasons as set forth below.

Before directly addressing the anticipation and obviousness rejections, the Applicant wishes to emphasize that the present invention is for an "illumination device", that is to say, one providing for the illumination of an object to enable features of the particular object to be comprehended by an observer. The class of such devices would include a reading lamp, a light to illuminate a road sign or a flood light for a church facade.

In contrast to this is a "signal" when energized functions to merely show its existence to an observer. An example of a signal would be a set of traffic lights, ship's lights or a lighthouse. The function of a "signal" is not comparable with that of an "illumination device". The fact that a "signal" may illuminate an object (including a surface) in the vicinity of the signal is incidental to its function. It is not intended to enable an observer to consider details of the illuminated object. A "signal" would also include a decorative device including a lamp which, when energized, provides for the device to be viewed as a decorative feature rather than one illuminating another object for the sake of the object.

An illuminating device is intended to illuminate objects other than itself and contrasts with a signal which is intended to draw attention to itself for whatever reason.

Claims 11, 14-16, 18, 21 and 24-26 are rejected, under 35 U.S.C. § 102(b), as being anticipated by Kaye '021. The Applicant acknowledges and respectfully traverses the raised anticipatory rejection in view of the following remarks.

The Examiner has newly cited Kaye '021. As the Examiner is aware, in order to properly support an anticipation rejection under The cited reference must disclose each and

every feature of the presently claimed invention. Claim 29 specifically claims "An illumination device comprising . . .". It is believed that the distinction between the class of "illuminating devices" as distinctly claimed, and the class of "signals" serves to clearly distinguish the "illuminating device" of the present invention from the "signal" of Kaye `021.

In his specification, Kaye `021 goes to considerable lengths and repeatedly states that his concern is with "ornament displaying furniture" which is to say with appearance. He exemplifies a number of embodiments providing for the interior of his columnar furniture to be readily accessed to enable changes to be made to the contents or layout so as to provide for a changed appearance. It follows that Kaye `021 is not concerned with providing a light source located within an enclosure with efficient light coupling between the light source and the outside of his furniture to illuminate a region near the furniture but rather with changing the appearance of his furniture when viewed from outside. Kaye `021 does not suggest the use of solid state light emitting devices. The efficiency of light transmission or the ability to illuminate is nowhere touched on by Kaye `021. Rather Kaye `021 makes a virtue of being able to open up his furniture to change its contents with a selection or selections from a range of light influencing materials and so its appearance.

The intentions and disclosure of Kaye `021 does not accord with those of the present invention whose concern is with an illuminating device as discussed in the original specification and subsequently. The device of the present invention is not concerned with what the device looks like and how that appearance can be varied, but with the illumination of an object to best effect. The fresh claims are directed to emphasizing these ends.

The Examiner asserts (paragraph 12) that Kaye `021 discloses the present invention or (paragraph 13) renders it obvious to one of ordinary skill in the art. Kaye `021 in his furniture does not disclose an illuminating device (as discussed earlier) nor a device capable of functioning as the present invention does. This is not surprising since Kaye `021 is not concerned with solving the problem overcome by the present invention. It is not clear what art

and what skill is referred to here. However, it is clear that the furniture of Kay '021 is not in the same field of endeavor as the illuminating device of the present invention.

Regarding the rejection of previous claims 18 and 21, a new independent claim 39 is presented. The Examiner has indicated on page 4 of the Official Action that the feature of air, gas or vapor being maintained at a controlled pressure relative to atmospheric pressure is inherent. However, even to rise to a level of inherency there must be some express or at least implied disclosure, teaching or suggestion of such a specific feature in the cited reference in order to anticipate the recited claim limitation. Although, in general, inherency arguments are used to support obviousness rejections, the same fundamental principal holds true for anticipation as well. The Federal Circuit has long held that there must be some such disclosure, "[s]uch a retrospective view of inherency is not a substitute for some teaching or suggestion supporting an obviousness rejection." See In re Newell, 891 F.2d 899, 901, 13 USPQ2d 1248, 1250 (Fed.Cir. 1989). To establish inherency, the extrinsic evidence must make clear that the missing descriptive material is necessarily present in the thing described in the reference, and that it would be recognized by persons of ordinary skill. However, inherency may not be established by probabilities or possibilities. In re Robertson, (Fed.Cir. 1999).

The Applicant takes issue with the supposition that a pressurized gas or vapor is disclosed, taught or suggested in any manner, either expressly or inherently by the cited reference which intends that the reflective fill material can actually be changed if necessary. At column 3, lines 59-63, the disclosure states, "[o]ther decorative material may be used within the column 13 to alter the appearance of the stool at will . . . To do so, it is only necessary to remove the seat 11 from the top of the column 13, pour out the fill which may be ball elements or marbles and replace such material with other decorative elements of choice".

It is the Applicant's position that such a feature as disclosed in Kaye '021 certainly does not disclose a pressurized internal body member as recited in Applicant's claim 39 ". . . an interior of the body member not occupied by the at least one source of light or the optical

particles is filled with a gas or vapor maintained at a controlled pressure relative to ambient atmospheric pressure". The decorative nature of the fill material of Kaye '021 if anything, teaches inherently that air at ambient temperature is within the interior of the body. Otherwise, changing of the fill material would be significantly more difficult if not impossible.

Therefore, as this specifically claimed feature of the present invention is not disclosed, taught or suggested in any manner, either expressly or inherently, the Applicant respectfully requests withdrawal of the anticipation rejection and believes claim 39 to be allowable as well.

Claims 12, 17, 22 and 27 are rejected, under 35 U.S.C. § 103(a), as being unpatentable over George, Jr. '458 in view of Lew et al. '974. These claims which correspond directly to claims 30, 35 of the newly submitted claims are directly dependent on new independent claim 29, which is believed to be allowable in view of the above remarks, and thus these dependent claims are believed allowable as well.

Claims 13 and 23, corresponding to new claim 31 are rejected, under 35 U.S.C. § 103(a), as being unpatentable over Kaye '021. Again, as this claim is directly dependent on new independent claim 29, which is believed to be allowable in view of the above remarks, and thus this dependent claim is believed allowable as well.

If any further amendment to this application is believed necessary to advance prosecution and place this case in allowable form, the Examiner is courteously solicited to contact the undersigned representative of the Applicant to discuss the same.

In view of the above amendments and remarks, it is respectfully submitted that all of the raised rejection(s) should be withdrawn at this time. If the Examiner disagrees with the Applicant's view concerning the withdrawal of the outstanding rejection(s) or applicability of the Kaye '021, George, Jr. '458 and/or Lew et al. '974 references, the Applicant respectfully requests the Examiner to indicate the specific passage or passages, or the drawing or drawings, which contain the necessary teaching, suggestion and/or disclosure required by case law. As such teaching, suggestion and/or disclosure is not present in the applied references, the raised rejection should be withdrawn at this time. Alternatively, if the Examiner is relying

on his/her expertise in this field, the Applicant respectfully requests the Examiner to enter an affidavit substantiating the Examiner's position so that suitable contradictory evidence can be entered in this case by the Applicant.

In view of the foregoing, it is respectfully submitted that the raised rejection(s) should be withdrawn and this application is now placed in a condition for allowance. Action to that end, in the form of an early Notice of Allowance, is courteously solicited by the Applicant at this time.

The Applicant respectfully requests that any outstanding objection(s) or requirement(s), as to the form of this application, be held in abeyance until allowable subject matter is indicated for this case.

In the event that there are any fee deficiencies or additional fees are payable, please charge the same or credit any overpayment to our Deposit Account (Account No. 04-0213).

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'S. Daniels', is written over a horizontal line.

Scott A. Daniels, Reg. No. 42,462
Customer No. 020210
Davis & Bujold, P.L.L.C.
Fourth Floor
500 North Commercial Street
Manchester NH 03101-1151
Telephone 603-624-9220
Facsimile 603-624-9229
E-mail: patent@davisandbujold.com